



IFW

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Patent application of	:	Attorney Docket No.:
	David T. Ou-Yang	:	185616 (9446-139US1)
		:	
		:	Group Art: 1775
Serial No.:	10/660,095	:	
		:	
Filed:	September 11, 2003	:	Examiner: Xu, Ling X.
		:	
For:	DECORATIVE ARTICLE AND	:	Confirmation No. 5926
	METHODS OF MAKING THE SAME	:	

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the office action mailed September 20, 2004. This response is being filed within the first month after the one month shortened statutory period set by the action. A request for a one month extension of time and the appropriate fee accompany this response. This extension resets the response deadline to November 20, 2004. Authorization is provided to charge any additional fee associated with this response, or to credit any overpayment, to Deposit Account No. 50-0573.

<p style="text-align: center;">CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8(a)</p> <p>I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date indicated below, with sufficient postage, as first class mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.</p> <p>BY <u><i>Patricia A. Oliveira</i></u></p> <p>DATE: <u><i>November 18, 2004</i></u></p>
--

Election of Invention

Applicant elects, with traverse, Group I (claims 1-7 and 11-15). Reconsideration of the Restriction Requirement in all aspects is requested in view of the following remarks.

The present claims have been restricted into two groups:

Group I (claims 1-7 and 11-15), drawn to a decorative element.

Group II (claims 8-10), drawn to a method of making the decorative element.

In showing the distinction between Group I and Group II, the Examiner alleges that the method of making the decorative element can be used to make other and materially different products such as a product with the ink layer applied on the *outer* surface of the loops. The Applicant respectfully traverses the Examiner's argument.

The Group I claims recite a decorative element that includes "a colorant layer disposed on a second surface of the polymeric layer or the high refractive index layer, the colorant layer forming the *inner* surface of the loops." See Claim 1 (emphasis added). The Group I claims also recite that the colorant layer can comprise ink. See Claim 4.

By comparison, the Group II claims recite a method for making a decorative element, the method including "applying a colorant to a second surface of the polymeric layer or the high refractive index layer; and forming a plurality of loops of the film having an inner surface and an outer surface, the *inner* surface being the colorant layer of the film." See Claim 8 (emphasis added). The Group II claims also recite that "the applying step [in claim 8] comprises applying an ink to the film." See Claim 9. In other words, as claimed, the Group II claims recite a method of making a product with the ink layer applied on the *inner* surface of the loops. The Group II claims do not, as the Examiner alleges, recite a method of making a product with the ink layer applied on the outer surface of the loops.

In sum, in both the Group I and II claims, the colorant is on the *inner* surface of the film. Also, in both the Group I and II claims, the colorant is ink. Moreover, neither the Group I claims nor the Group II claims recite applying a colorant (or ink) layer to the outer surface of the loops. Consequently, the Examiner's argument that the Group II claims can be used to make other and materially different products such as a product with the ink layer applied on the *outer* surface of the loops is respectfully traversed.

Because the Examiner's argument as to the restriction requirement has been respectfully traversed, Applicant requests that the Group I and II claims be rejoined for examination on the merits.

Respectfully submitted,

DAVID T. OU-YANG

By: 

THOMAS J. DURLING

Registration No. 31,349

DRINKER BIDDLE & REATH LLP

One Logan Square

18th and Cherry Streets

Philadelphia, PA 19103-6996

Phone: (215) 988-3307

Fax: (215) 988-2757

Attorney for Applicants